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EXAMINER

SPAHN, GAY

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/806,592	<b>Applicant(s)</b> COLLIER ET AL.	
	<b>Examiner</b> Gay Ann Spahn	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/23/2004, 11/05/2007, & 5/20/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 13-16, 18, 19, 24-30, 32-36, 39, 43-53, 55 and 57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 17, 20-23, 31, 37, 38, 40-42, 54, and 56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)                     | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of GROUP I (i.e., claims 1-42, 49, and 54-57), SPECIES I (i.e., Fig. 1) of the FIRST GROUP OF SPECIES, SPECIES I (i.e., molding matrix around insulating element) of the SECOND GROUP OF SPECIES, and SPECIES I (i.e., polystyrene) of the THIRD GROUP OF SPECIES in the replies filed on 05 November 2007 and 20 May 2008 is acknowledged.

Applicant has listed claim 55 as reading on elected SPECIES I (i.e., Fig. 1) of the FIRST GROUP OF SPECIES. The examiner disagrees because claim 55 recites that "the insulating element protrudes beyond one end of each said blocks forming a mating tongue" and this clearly reads on SPECIES IV (i.e., Fig. 13).

Applicant has listed claim 57 as reading on elected SPECIES I (i.e., molding matrix around insulating element) of the SECOND GROUP OF SPECIES. Because claim 57 is dependent upon claim 29 which does not read on elected SPECIES I (i.e., molding matrix around insulating element) of the SECOND GROUP OF SPECIES, it also does not read on elected SPECIES I (i.e., molding matrix around insulating element) of the SECOND GROUP OF SPECIES.

Claims 43-48 and 50-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected INVENTION, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 05 November 2007.

Claims 13-16, 18, 19, 24-30, 32-36, 39, 49, 55, and 57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected SPECIES, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 20 May 2008.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Australia on 24 March 2003. It is noted, however, that applicant has not filed a certified copy of the Australian application (i.e., 2003901351) as required by 35 U.S.C. 119(b).

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a

separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the

(1) "block" (see page 10, lines 5-6, wherein it states that "[e]ach formation provides a keying in profile for mutual engagement between element 1 and a block not shown").

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because:

- (1) Fig. 1, the longitudinal axis should not be a solid line;
- (2) Fig. 2, if reference numeral “3” is on the structure it represents, then it should be underlined;
- (3) Fig. 3, the “black” rectangles at the top of blocks 32, 33, and 34 are not understood and should not be completely “black” and the “diagonal cross-hatching” for insert 39 is also not understood and should be deleted;
- (4) Fig. 4, if the “speckling” on the blocks 44, 45, 46, and 47 is supposed to be showing “concrete” material, then Applicant should use the symbol in the Manual of Patent Examining Procedure (MPEP), section 608.02, IX, entitled “Drawing Symbols”;
- (5) Fig. 8, if blocks 58, 59, 60, and 61 are “concrete” material, the Applicant should use the symbol in MPEP, section 608.02, IX, entitled “Drawing Symbols”;
- (6) Figs. 14-17, is the “speckling” the correct symbol for the material in blocks 77, 78, 79, and wall section 82; and
- (7) Figs. 14-17, is the “dark speckling” the correct symbol for the material in block 95.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. Below is but a few of the errors detected by the examiner.

The disclosure is objected to because of the following informalities:

(1) throughout the specification, the words "mould" "moulded", and "moulding" should be changed to the U.S. spelling of --mold--, --molded--, and --molding--;

(2) page 1, line 6 (i.e., line beginning with “a mortar matrix”), the second period punctuation mark should be deleted;

(3) page 2, line 6, the period punctuation mark should be moved to be adjacent the last letter of the last word;

(4) page 3, line 16, the second period punctuation mark should be deleted;

(5) page 8, line 3, at the end of the line the semi-colon should be changed to a colon;

(6) page 8, line 6, at the end of the line the period punctuation mark should be changed to a semi-colon;

(7) page 8, line 7, the word “insulting” should be changed to –insulating--;

(8) page 8, line 8, at the end of the line a semi-colon should be inserted;

(9) page 8, line 10, at the end of the line the period punctuation mark should be changed to a semi-colon;

(10) page 8, line 12, at the end of the line the period punctuation mark should be changed to a semi-colon;

(11) page 8, line 14, at the end of the line a semi-colon should be inserted;

(12) page 8, line 16, at the end of the line the period punctuation mark should be changed to a semi-colon;

(13) page 8, line 18, at the end of the line the period punctuation mark should be changed to a semi-colon;

(14) page 8, line 20, at the end of the line the word "an" should be deleted;



(15) page 8, line 22, at the end of the line the period punctuation mark should be changed to a semi-colon;

(16) page 9, line 2, at the end of the line the period punctuation mark should be changed to a semi-colon;

(17) page 9, line 3, at the end of the line the period punctuation mark should be changed to a semi-colon;

(18) page 9, line 5, at the end of the line the period punctuation mark should be changed to a semi-colon;

(19) page 9, line 6, at the end of the line the period punctuation mark should be changed to a semi-colon;

(20) page 9, line 7, at the end of the line the period punctuation mark should be changed to a semi-colon;

(21) page 9, line 9, at the end of the line the period punctuation mark should be changed to a semi-colon and the word --and-- should be inserted;

(22) page 9, last line, the word "Element" should not be capitalized;

(23) page 11, line 7, change reference numerals "10" and "12" to --33-- and --34--, respectively;

(24) page 12, line 7, reference numeral "64" should be deleted as not being the insulating element, but rather being the outer face as described in line 5; and

(25) page 18, line 16, "180" and "150" should be given units such as millimeters or whatever is appropriate.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-12, 17, 20-23, 31, 37, 38, 40-42, 54, and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 1**, lines 4-5, the recitation of “at least one formation on or in at least the inner face and/or at least one of the end surfaces which receive/s and retain/s at least one insulating element” is vague, indefinite, and confusing as not being understood. The U-shaped end profiles (15, 16) of Fig. 1 are not “formations . . . which receive/s and retain/s at least one insulating element” (1) because the U-shaped end profiles (15, 16) appear to accept the insert (28) as shown in Fig. 3 and the insert (28) does not help to retain the insulating element (1) in the construction block. So it does not appear that there can be a “formation . . . which receive/s and retain/s at least one insulating element” in either of the end surfaces of the body of the construction.

**Claim 1**, lines 6-7, the recitation of “said construction blocks” is vague, indefinite, and confusing as lacking antecedent basis since only a single construction block has been previously recited.

**Claim 2**, lines 3-4, the recitation that “the element is secured to said block via said at least one formation” is vague, indefinite, and confusing as not being understood.

How is the insulating element “secured to said block via said at least one formation” when the insulating element is a part of said block?

**Claim 3**, lines 2-3, the recitation of “at least one face of each said building blocks” is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if “at least one face” refers back to “at least one inner face” or is a new face or what “said building blocks” refers back to since only a single construction block has been previously recited.

**Claim 4**, lines 1-2, the recitation of “each formation comprises a recess which provides a key to secure each said element to the block” is vague, indefinite, and confusing since the formations in the insulating element (1) has dovetail formations that are recesses, but the formations of the concrete which is what was introduced in claim 1 are not recesses, but rather are projections.

**Claim 6**, lines 1-2, the recitation that “the block includes a formation in a surface which accommodates a corresponding formation in said insert” is vague, indefinite, and confusing as lacking antecedent basis. Is “a formation” an additional formation or does it refer back to the formation previously introduced in claim 1? Is “a surface” an additional surface or does it refer back to one of the surfaces previously introduced in claim 1? Is “a corresponding formation” a new formation or does it refer back to the formation previously introduced in claim 1? What does “said insert” refer back to as no insert has been previously introduced?

**Claim 7**, lines 1-2, the recitation that “the insert engages an inner surface of the block via said formations” is vague, indefinite, and confusing as lacking antecedent

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basis. What does "the insert" refer back to when no insert has been introduced? Does "said formations" refer back to the formations recited in claim 6 and is one of those formations, the same formation as introduced in claim 1? Is "an inner surface" a new surface or is it trying to refer back to one of the surfaces or the inner face introduced in claim 1?

**Claim 8**, lines 1-2, the recitation that "the formations which allow engagement between a construction block and said element are opposite gender" is vague, indefinite, and confusing as lacking antecedent basis and as not being understood. Does "said formations" refer back to the formations recited in claim 6 and is one of those formations, the same formation introduced in claim 1? What does "opposite gender" mean (i.e., is this reciting structure such a female formation and a male formation)?

**Claim 9**, lines 1-2, the recitation of "each said element engages adjacent blocks" is vague, indefinite, and confusing as not being understood. How does the insulating element engage adjacent blocks?

**Claim 10**, lines 1-2, the recitation of "an insulating element engages an end of a first construction block and an opposing end of a second adjacent constructions block" is vague, indefinite, and confusing as lacking antecedent basis. Does "an insulating element" refer back to the insulating element introduced in claim 1 or is it an additional insulating element? Does "a first construction block" and "a second adjacent constructions block" refer back to the construction block introduced in claim 1?

**Claim 11**, lines 1-2, the recitation of “an insulating element engages an inner wall of a first block and an inner wall of an opposing block” is vague, indefinite, and confusing as lacking antecedent basis. Does “an insulating element” refer back to the insulating element introduced in claim 1 or is it an additional insulating element? Does “a first block” and “an opposing block” refer back to the construction block introduced in claim 1 or are these additional construction blocks? Does “an inner wall” refer back to the inner face introduced in claim 1?

**Claim 12**, lines 1-2, the recitation of “each insulating element is substantially the same dimension as one dimension of one face of said block” is vague, indefinite, and confusing for lacking antecedent basis. Does “one face” refer back to any of the surfaces or the inner face introduced in claim 1?

**Claim 31**, line 1, the recitation of “the insulating element according to claim 1” is vague, indefinite, and confusing because claim 1 is drawn to a construction block, not an insulating element.

**Claim 31**, lines 1-2, the recitation of “an insulating element has one dimension substantially the same as one dimension of one face of said block” is vague, indefinite, and confusing as lacking antecedent basis. Is “an insulating element” referring back to the insulating element introduced in claim 1 or is it an additional insulating element? Does “one face” refer back to any of the surfaces or the inner face introduced in claim 1?

**Claim 56**, lines 1-2, the recitation of “wherein an insulating element engages an inner wall of a first block and an inner wall of an opposing block” is vague, indefinite,

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and confusing as lacking antecedent basis. Is “an insulating element” referring back to the insulating element introduced in claim 1 or is it an additional insulating element?

Does either of “an inner wall of a first block” or “an inner wall of an opposing block” refer back to the inner face and the construction block introduced in claim 1?

**Claim 20**, lines 4-6, the recitation of “at least one formation on or in at least the inner face and/or at least one of the end surfaces which receive/s and retain/s at least one insulating element” is vague, indefinite, and confusing as not being understood. The U-shaped end profiles (15, 16) of Fig. 1 are not “formations . . . which receive/s and retain/s at least one insulating element” (1) because the U-shaped end profiles (15, 16) appear to accept the insert (28) as shown in Fig. 3 and the insert (28) does not help to retain the insulating element (1) in the construction block. So it does not appear that there can be a “formation . . . which receive/s and retain/s at least one insulating element” in either of the end surfaces of the body of the construction.

**Claim 22**, lines 2-3, the recitation of “at least one face of each said building blocks” is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if “at least one face” refers back to “at least one inner face” or is a new face or what “said building blocks” refers back to since only a single construction block has been previously recited.

**Claim 23**, lines 1-3, the reaction of “wherein each formation in the construction block includes a recess providing a key to secure an insert to the block” is vague, indefinite, and confusing as not being understood. Doesn’t the formation provide a key

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to secure the insulating element (1) to the block, not the insert (28) as recited in claim 4?

**Claim 37**, lines 1-3, the recitation of “A structure manufactured from building blocks comprising a body having a bottom surface, a top surface, end surfaces, and outer surface which forms part of an outer surface of a structure and an inner face” is vague, indefinite, and confusing as not being understood. Is the body having the recited surfaces and inner face part of the structure or part of the building blocks?

**Claim 37**, lines 3-5, the recitation of “at least one formation on or in at least the inner face and/or at least one of the end surfaces which receive/s and retain/s at least one insulating element” is vague, indefinite, and confusing as not being understood. The U-shaped end profiles (15, 16) of Fig. 1 are not “formations . . . which receive/s and retain/s at least one insulating element” (1) because the U-shaped end profiles (15, 16) appear to accept the insert (28) as shown in Fig. 3 and the insert (28) does not help to retain the insulating element (1) in the construction block. So it does not appear that there can be a “formation . . . which receive/s and retain/s at least one insulating element” in either of the end surfaces of the body of the construction.

**Claim 37**, lines 5-7, the recitation of “wherein, the insulating element provides thermal insulation for the structure formed from a composite building element comprising said blocks and said insulating element” is vague, indefinite, and confusing as not being understood. Isn't the composite building element the same structure as the building blocks so that Applicant is using two different terminologies for the same structure?

**Claim 38**, lines 2-4, the recitation of “wherein, said element approximates the size of at least one face of a building block with which the insulating element is used” is vague, indefinite, and confusing as not being understood. How does the element “approximate the size of at least one face of building block with which the insulating element is used? If Applicant is trying to say that a face of the element and a face of the block are the same length and width, then this should be more clearly recited.

**Claim 38**, lines 4-6, the recitation of “wherein, the polystyrene insert “is adapted for integral attachment with at least one said building blocks such that a composite building element comprising said element and at least one said blocks is formed” is vague, indefinite, and confusing as lacking antecedent basis. No "polystyrene insert" has been previously introduced.

**Claim 40**, lines 5-6, the recitation of “each said building blocks” is vague, indefinite, and confusing as lacking antecedent basis since only a single construction block has been previously recited.

**Claim 41**, lines 2-3, the recitation of “said composite” is vague, indefinite, and confusing as lacking antecedent basis.

**Claim 42**, lines 2-3, the recitation of "A composite block including an insulating element wherein the block is either a rectangular cube, square cube, triangular cube, polygonal" is vague, indefinite, and confusing as not being understood. The definition of a cube is "a solid bounded by six equal squares, the angle between any two adjacent faces being a right angle" so that it is not understood what is meant by a "rectangular cube", "square cube", or "triangular cube". Also, what is meant by polygonal (i.e., does



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Applicant mean polygon?). Also, the word “either” should only be used when comparing two things and the recitation should be recited in Markush group language so the examiner suggest amending to --the block is of a shape selected from the group consisting of rectangular, square, triangular, and polygonal--.

**Claim 54**, lines 4-6, the recitation of “wherein, the insulating element is integrally attached to an inner face of at least one said blocks to thereby provide a thermal and water barrier to at least one face of each said building blocks” is vague, indefinite, and confusing as not being understood. How can an insulating element attached to an inner face of a single block provide a thermal and water barrier to the face of each of two adjacent building blocks?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-12, 17, 31, 56, 20-23, 37, 38, 40-42, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by MAGERLE (U.S. Patent No. 4,055,928).**

**As to claim 1** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses a construction block for use in the construction of elemental structures, the block comprising

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a body (body of block shown in cross-sectional in Fig. 1) having a bottom surface, a top surface, end surfaces, an outer surface “which forms part of an outer surface of a structure” (the structure of MAGERLE is capable of performing the recited intended use within quotation marks) and an inner face;

at least one formation (8) on or in at least the inner face (inner face of 6) and/or at least one of the end surfaces which receive/s and retain/s at least one insulating element (1);

wherein, the insulating element (1) provides thermal insulation “for a structure formed from said construction blocks” (the structure of MAGERLE is capable of performing the recited intended use within quotation marks).

**As to claim 2** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 1 as discussed above, and MAGERLE also discloses that the at least one insulating element (1) comprises a prismatic body made from a material (expanded plastics material, for example, polystyrene – see col. 2, lines 27- 28) having insulating properties (polystyrene has insulating properties); wherein the element (1) is secured to said block (block shown in cross-section in Fig. 1) via said at least one formation (8).

**As to claim 3** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 2 as discussed above, and MAGERLE also discloses that each said insulating element (1) provides a thermal and water barrier.

**As to claim 4** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 3 as discussed above, and MAGERLE also discloses that each formation (8) comprises a recess (2) which provides a key to secure each said element (1) to the block (block shown in cross-section in Fig. 1).

**As to claim 5** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 4 as discussed above, and MAGERLE also discloses that the construction block (block shown in cross-section in Fig. 1) is formed in a mould (this is a product-by process limitation and in product-by-process claiming, it is the product that is being claimed and forms the patentable part of the invention – but see Figs. 2 and 3 and col. 3, lines 12-24) from a cementitious matrix (two part shell 6 is concrete – see col. 2, line 40).

**As to claim 6** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 5 as discussed above, and MAGERLE also discloses that the block (block shown in cross-section in Fig. 1) includes a formation (8) in a surface (inner surface of 6, 6) which accommodates a corresponding formation (2) in said insert (1).

**As to claim 7** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 6 as discussed above, and MAGERLE also discloses that the insert (1)

engages an inner surface (inner surface of shells 6, 6) of the block (block shown in cross-section in Fig. 1) via said formations (2, 8).

**As to claim 8** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 7 as discussed above, and MAGERLE also discloses that the formations (2, 8) which allow engagement between a construction block (block shown in cross-section in Fig. 1) and said element (1) are opposite gender (male projection 8 and female recess 2).

**As to claim 9** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 8 as discussed above, and MAGERLE also discloses that each said element (1) engages adjacent blocks (6, 6).

**As to claim 10** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 9 as discussed above, and MAGERLE also discloses that an insulating element (1) engages an end (7) of a first construction block (6 of block shown in cross-section in Fig. 1) and an opposing end (7) of a second adjacent constructions block (6 of block shown in cross-section in Fig. 1).

**As to claim 11** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 9 as discussed above, and MAGERLE also discloses that an insulating element (1) engages an inner wall (inner wall of 6) of a first block (6 of block shown in

cross-section in Fig. 1) and an inner wall (inner wall of 6) of an opposing block (6 of block shown in cross-section in Fig. 1).

**As to claim 12** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 1 as discussed above, and MAGERLE also discloses that each insulating element (1) is substantially the same dimension as one dimension of one face of said block (6 of block shown in cross-section in Fig. 1).

**As to claim 31** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the insulating element [sic – construction block] according to claim 1 as discussed above, and MAGERLE also discloses an insulating element (1) has one dimension substantially the same as one dimension of one face of said block (6 of block shown in cross-section in Fig. 1).

**As to claim 56** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the construction block of claim 10 as discussed above, and MAGERLE also discloses that an insulating element (1) engages an inner wall (inner wall of 6) of a first block (6) and an inner wall (inner wall of 6) of an opposing block (6).

**As to claim 20** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses an insulating element for use in a construction block for use in the construction of elemental structures, the block comprising:

a body having a bottom surface, a top surface, end surfaces, an outer surface which forms part of an outer surface of a structure and an inner face;

at least one formation on or in at least the inner face and/or at least one of the end surfaces which receive/s and retain/s at least one insulating element;

wherein, the insulating element (1) provides thermal insulation “for a structure formed from said construction blocks” (the structure of MAGERLE is capable of performing the recited intended use within quotation marks).

The examiner notes that only the insulating element has been claimed and the recitation of the block and the structure of the block has not been given any patentable weight as not being positively recited having only been introduced in an intended use phrase in the preamble and not being connected or related to the structure of the insulating element.

**As to claim 21** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the insulating element of claim 20 as discussed above, and MAGERLE also discloses that the insulating element (1) comprises a prismatic body made from a material (expanded plastics material, for example, polystyrene – see col. 2, lines 27- 28) having insulating properties (polystyrene has insulating properties); “wherein the element is connected to the block via said at least one formation” (the structure of MAGERLE is capable of performing the recited intended use within quotation marks).

**As to claim 22** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the insulating

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element of claim 21 as discussed above, and MAGERLE also discloses that each said element (1) provides “a thermal and water barrier to at least one face of each building block” (the structure of MAGERLE is capable of performing the recited intended use within quotation marks).

**As to claim 23** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses the insulating element of claim 22 as discussed above, and MAGERLE also discloses that each formation in the construction block includes a recess providing a key to secure an insert to the block.

The examiner notes that only the insulating element has been claimed and the recitation of the block and the structure of the block has not been given any patentable weight as not being positively recited having only been introduced in an intended use phrase in the preamble and not being connected or related to the structure of the insulating element.

**As to claim 38** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses an insulating element “for use in the thermal insulation of a wall constructed from building blocks made from a cementitious material” (the structure of MAGERLE is capable of performing the recited intended use within quotation marks);

wherein, said element (1) approximates the size of at least one face of a building block with which the insulating element (1) is used,

wherein, the polystyrene insert “is adapted for integral attachment with at least one said building blocks such that a composite building element comprising said element and at least one said blocks is formed” (the structure of MAGERLE is capable of performing the recited intended use within quotation marks).

The examiner notes that only the insulating element has been claimed and the recitation of the block has not been given any patentable weight as not being positively recited having only been introduced in an intended use phrase in the preamble and not being connected or related to the structure of the insulating element.

Further, the insert has not been given any patentable weight as not being positively recited.

**As to claim 40** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses a composite construction element “for use in the construction of an elemental structure” (the structure of MAGERLE is capable of performing the recited intended use within quotation marks); wherein, the composite element comprises

a construction block (6, 6) and an insulating element (1) made from a material (expanded plastics material, for example, polystyrene – see col. 2, lines 27- 28) having insulating properties (polystyrene has insulating properties);

wherein, the insulating element (1) is integrally attached to an inner face of the block (6, 6) to thereby provide a thermal and water barrier to at least one face of each said building blocks.



**As to claim 41** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses a composite building block including

an insulating element (1) wherein the element (1) provides “a thermal and moisture barrier to said block (block shown in cross-section in Fig. 1)

wherein, said composite is prepared in a mould and the block (block shown in cross-section in Fig. 1) is formed from a cementitious matrix (two part shell 6 is concrete – see col. 2, line 40);

wherein said matrix is poured in said mould while said polystyrene element (1) is in said mould (the examiner notes that this is a product-by-process limitation and in product-by-process claiming, it is the product that is claimed and forms the patentable part of the invention);

wherein the element (1) and block (block shown in cross-section in Fig. 1) mutually engage by opposing gender formations (8, 2) to form the composite block (block shown in cross-section in Fig. 1).

**As to claim 42** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses a composite construction block including

an insulating element (1) wherein the block (block shown in cross-section in Fig. 1) is either a rectangular cube, square cube, triangular cube, polygonal.

**As to claim 54** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses a composite

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construction element “for use in the construction of an elemental structure” (the structure of MAGERLE is capable of performing the recited intended use within quotation marks);

wherein, the composite element (block shown in cross-section in Fig. 1) comprises first and second spaced apart construction blocks (6,6) and an insulating element (1) made from a material (expanded plastics material, for example, polystyrene – see col. 2, lines 27- 28) having insulating properties (polystyrene has insulating properties);

wherein, the insulating element (1) is integrally attached to an inner face of at least one said blocks (6, 6) to thereby provide a thermal and water barrier to at least one face of each said building blocks.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 37 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MAGERLE (U.S. Patent No. 4,055,928).**

**As to claim 37** (and as best understood despite the 35 U.S.C. § 112, second paragraph, indefiniteness discussed above), MAGERLE discloses a structure (wall –

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see col. 1, lines 14-15 and col. 2, lines 60-61) manufactured from building blocks (two or more of casing bricks shown in cross-section in Fig. 1) comprising

a body (body of block shown in cross-section in Fig. 1) having a bottom surface, a top surface, end surfaces, an outer surface "which forms part of an outer surface of a structure" and an inner face;

at least one formation (8) on or in at least the inner face (inner face of 6, 6) and/or at least one of the end surfaces which receive/s and retain/s at least one insulating element (1);

wherein, the insulating element (1) provides thermal insulation "for the structure formed from a composite building element comprising said blocks (body of block shown in cross-section in Fig. 1) and said insulating element (1)" (the structure of MAGERLE is capable of performing the recited intended use within quotation marks).

If the wall of MAGERLE fails to explicitly disclose two or more casing bricks, then it certainly would have been obvious to one of ordinary skill in the art to make a wall (i.e., structure) comprised of two or more of the casing bricks of MAGERLE in order to arrange that no heat bridge is formed between the inside and outside of a wall built from the casing bricks which is of decisive importance for heat insulation (see col. 1, lines 41-44).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)272-

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7731. The examiner can normally be reached on Monday through Friday, 10:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571)-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gay Ann Spahn/  
Gay Ann Spahn, Primary Examiner  
July 4, 2008